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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,816	09/18/2003	Susann Marie Keohane	AUS920030442US1	8940
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IBM CORPORATION (VE) C/O VOLEL EMILE P. O. BOX 162485 AUSTIN, TX 78716			EXAMINER DAILEY, THOMAS J	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 04/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/666,816	Applicant(s) KEOHANE ET AL.	
	Examiner Thomas J. Dailey	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/1/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-40 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-6, 9-16, 19-26, 29-36, and 39-40, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1, 11, 21, and 31, recite, "excluding recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message," (e.g. claim 1, lines 14-16). The wording of this limitation renders the content of the list of recipients unclear. Are the excluded recipients still part of the list? It seems clear that they are not, according to the claim language, and if that is the case the list of recipients minus the excluded recipients, in fact becomes a new list or a least a modified list, and should be referred to as such.
5. Claims 4, 10, 14, 20, 24, 30, 34, 40 recite, "the stored email **may be** encrypted by a private key," (e.g. claim 4, lines 1-2). The recitation of "may be" renders the claim indefinite.

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6. Claims 9, 19, 29, and 39, recite, "the email message has a list of recipients, the list of recipients being modified by the sender" (e.g. claim 9, lines 1-2). The parent claims (7, 17, 27, and 37) recite, "the message being addressed to a list of recipients" (e.g. claim 7, lines 2-3). It is unclear how many lists of recipients there are, and which one is being modified.
7. Claims 2-6, 12-16, 22-26, 32-36 are rejected due to their dependence on the previously rejected claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 7-9, 11-13, 17-19, 21-23, 27-29, 31-33, and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Brogne et al (EP Pub. No. 1,087,321).
10. As to claim 1, Brogne discloses a method of rescinding previously transmitted e-mail messages by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:
storing the e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing the recipients to automatically access the e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the list of recipients (column 2, lines 15-19); and

excluding recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message (column 3, lines 32-41).

11. As to claim 7, Brogne discloses 1 method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing the e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing the recipients to automatically access the stored e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the list of recipients (column 2, lines 15-19); and

enabling the sender to modify the stored e-mail message (column 3, lines 32-41).

12. As to claims 11, 21, and 31, they are rejected by the same rationale set forth in claim 1's rejection.

13. As to claims 17, 27, and 37, they are rejected by the same rationale set forth in claim 7's rejection.

14. As to claims 2, 12, 22, and 32, Brogne discloses all recipients from the list are excluded (column 3, lines 32-41).

15. As to claims 3, 8, 13, 18, 23, 28, 33, and 38, Brogne discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (column 3, lines 39-41).

16. As to claims 9, 19, 29, and 39 Brogne discloses the e-mail message has a list of recipients, the list of recipients being modified by the sender (column 3, lines 32-41).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4-6, 10, 14-16, 20, 24-26, 30, 34-36, and 40 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brogne as applied to claims 1, 7, 11, 17, 21, 27, 31, and 37 above, and further in view of what is well known in the art.

19. As to claim 4, 10, 14, 20, 24, 30, 34, and 40, Brogne discloses the invention substantially with regard to the parent 1, 7, 11, 17, 21, 27, 31, and 37, and further discloses the notification message for automatically accessing the e-mail message being a password (column 5, lines 21-24).

Although, Brogne does not explicitly disclose that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne in order to achieve such benefits.

20. As to claims 5, 15, 25, and 35, Brogne and what is well known in the art disclose the invention substantially with regard to the parent claim 4, 14, 24, and 34, and

further disclose the computing system is the computing system on which the e-mail message was composed (Brogne, column 4, lines 12-26).

21. As to claims 6, 16, 26, and 36, Brogne and what is well known in the art disclose the invention substantially with regard to the parent claim 4, 14, 24, and 34, and further disclose the computing system is a server, the server generating and sending the notification message to the recipients and sender (column 2, lines 12-19).


Conclusion

22. For additional prior art made of record and not relied upon and considered pertinent to applicant's disclosure see attached Notice of References Cited, Form PTO-892.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TJD
4/24/2007


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